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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,346	01/18/2002	Bruce B. Fitts	RGP-0072	9834
23413	7590	03/09/2004	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			LE, HOA VAN	
			ART UNIT	PAPER NUMBER

1752

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,346

Applicant(s)

FITTS ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-89 with broadest independent claim 1 as the main invention is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

This application is before the examiner for consideration on the merits.

- I. The record shows that the specification has been amended. If a new matter is found, please see the authority stated in *Tronzo v. Biomet Inc.*, 41 USPQ2d 1403.
- II. The record shows that applicants fail to precisely point out a support for each of the amended embodiments by clearly cite page and line for a timely consideration.
- III. There are 89 claims in eight groups of the claims (1-10), (11-16), (17-39), (40-60), (61), (62), (63-76) and (77-89) with the broadest independent claim 1 as the main invention. They are not considered to be patentably different or distinct. Therefore, no election of species or restriction is made. Accordingly, no separation or search is made. Should applicants show or urge otherwise in the next response to this application in order for it to be considered timely. An election of species, restriction or both of them will be made for the record as shown or urged.
- IV. The disclosure in the specification shows that no new chemical ingredient is disclosed or applied in the invention.
- V. A. (1) It is allowed to claim by a functional, characteristic, physical and/or chemical property of a material and /or process. (2) However, a claimed functional, characteristic, physical and/or chemical property of a material and/or process carries with a risk (*In re In re Schreiber*, 44

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USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, physical and/or chemical properties as claimed in accordance with the authority stated in *In re Best*, 195 USPQ 430; *Ex parte Maizel*, 27 USPQ2d 1662 or *Ex parte Phillip*, 28 USPQ2d 1302. The language “electrically and thermally conductive core”, “active area”, “electrically and thermally conductive polymeric composite” or the like is considered as the functional and characteristic, chemical and/or physical property of a material.

(B) *In re Schreiber*, 44 USPQ2d 1429 state that “A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in *Swinehart*... where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.” An argument may be given a little to no value. Applicants are now notified.

VI. Applicants' prior art submission has been considered in English language as provided.

VII. An initial search has found about two dozens of the references that would be able to applied on at least the main invention of claim 1. A set of at least three references will be applied when each and all applied references on the record are overcome.

VIII. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims (1-10), (11-16), (17-39), (40-60), (61), (62), (63-76) and (77-89) with the broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over British patent no. 1,187,282, Ledjeff et al (5,733,678) and Landi et al (5,223,568).

Patentee in the British patent discloses, teaches and suggests a structure comprising at least two different kinds materials being next or substantially next to each other. Each of the materials has an uncovering or free body portion and is (electrically and thermally conductive to one having skilled in the art. Applicants are urged to show or provide a convincing evidence to the contrary as clearly pointed out and set forth in the above paragraph "V" above). Please see the whole disclosure of each of the applied references, especially in British patent at figure 3 and Examples. Patentee demonstrates a liquid electrochemical power. However, one having ordinary skill in the art would know and use the materials in a solid electrode power to obtain electrical conductive function for the known same function. Applicants are urged to show a convincing evidence to the contrary. For such disclosed dry electrochemical power in the invention, please see Ledjeff et al, ... especially at the figures and their descriptions. For the disclosed polymers in the invention, please see Landi et al..., especially at col.1:30 to 5:53. Other materials are known for their function and usefulness in the art. Applicants are urged to show or provide a convincing

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evidence that each of the claimed materials would provide an unusual or unexpected result over each of the equivalent materials for the same or about the same function from the above applied references or those in the submitted references on the record for a patentability of each of the claimed materials in order for each of them in the next response to this Office action in order for each of them to be considered timely. Any issue being newly raised after a final Office action would be late and not considered. Applicants are now notified. Since the above references are related to electrochemical powers, it would have been obvious to one having ordinary skill in the art to cite one or more conventional or known functional materials in the art for about the same result as known and applied in the art with no patentable value.

IX. Claims (1-10), (11-16), (17-39), (40-60), (61), (62), (63-76) and (77-89) with the broadest independent claim 1 as the main invention rejected under 35 U.S.C. 103(a) as being unpatentable over Ledjeff et al (5,733,678) and Landi et al (5,223,568).

Ledjeff et al disclose, teach and suggest a structure comprising at least two different kinds materials being next or substantially next to each other. Each of the materials has an uncovering or free body portion and is (electrically and thermally conductive to one having skilled in the art. Applicants are urged to show or provide a convincing evidence to the contrary as clearly pointed out and set forth in the above paragraph "V" above). Please see the whole disclosure of each of the applied references, especially in Ledjeff et al at the figures and their descriptions, col.1:58 to 9:53. For the disclosed polymers in the invention, please see Landi et al..., especially at col.1:30 to 5:53. Other materials are known for their function and usefulness in the art. Applicants are urged to show or provide a convincing evidence that each of the

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claimed materials would provide an unusual or unexpected result over each of the equivalent materials for the same or about the same function from the above applied references or those in the submitted references on the record for a patentability of each of the claimed materials in order for each of them in the next response to this Office action in order for each of them to be considered timely. Any issue being newly raised after a final Office action would be late and not considered. Applicants are now notified. Since the above references are related to electrochemical powers, it would have been obvious to one having ordinary skill in the art to cite one or more conventional or known functional materials in the art for about the same result as known and applied in the art with no patentable value.

X. Claims (1-10), (11-16), (17-39), (40-60), (61), (62), (63-76) and (77-89) with the broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (5,578,399), Ledjeff et al (5,733,678) and Landi et al (5,223,568).

Olsen discloses, teaches and suggests a structure comprising at least two different kinds materials being next or substantially next to each other. Each of the materials has an uncovering or free body portion and is (electrically and thermally conductive to one having skilled in the art. Applicants are urged to show or provide a convincing evidence to the contrary as clearly pointed out and set forth in the above paragraph "V" above). Please see the whole disclosure of each of the applied references, especially in Olsen at col.1:61 to 13:55. For such visual structure of a dry electrochemical power in the invention, please see Ledjeff et al,...especially at the figures and their descriptions. For the disclosed polymers in the invention, please see Landi et al..., especially at col.1:30 to 5:53. Other materials are known for their function and usefulness in the

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art. Applicants are urged to show or provide a convincing evidence that each of the claimed materials would provide an unusual or unexpected result over each of the equivalent materials for the same of about the same function from the above applied references or those in the submitted references on the record for a patentability of each of the claimed materials in order for each of them in the next response to this Office action in order for each of them to be considered timely. Any issue being newly raised after a final Office action would be late and not considered. Applicants are now notified. Since the above references are related to electrochemical powers, it would have been obvious to one having ordinary skill in the art to cite one or more conventional or known functional materials in the art for about the same result as known and applied in the art with no patentable value.

XI. Claims (1-10), (11-16), (17-39), (40-60), (61), (62), (63-76) and (77-89) with the broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Fronk et al (6,372,376), Ledjeff et al (5,733,678) and Landi et al (5,223,568).

Fronk et al disclose, teach and suggest a structure comprising at least two different kinds materials being next or substantially next to each other. Each of the materials has an uncovering or free body portion and is (electrically and thermally conductive to one having skilled in the art. Applicants are urged to show or provide a convincing evidence to the contrary as clearly pointed out and set forth in the above paragraph "V" above). Please see the whole disclosure of each of the applied references, especially in Fronk et al at the figures and their descriptions. For additive materials and their equivalent functional properties in an electrochemical power, please see Ledjeff et al,...especially at col.1:58 to 9:53. For the disclosed polymers in the invention, please

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see Landi et al..., especially at col.1:30 to 5:53. Other materials are known for their function and usefulness in the art. Applicants are urged to show or provide a convincing evidence that each of the claimed materials would provide an unusual or unexpected result over each of the equivalent materials for the same or about the same function from the above applied references or those in the submitted references on the record for a patentability of each of the claimed materials in order for each of them in the next response to this Office action in order for each of them to be considered timely. Any issue being newly raised after a final Office action would be late and not considered. Applicants are now notified. Since the above references are related to electrochemical powers, it would have been obvious to one having ordinary skill in the art to cite one or more conventional or known functional materials in the art for about the same result as known and applied in the art with no patentable value.

XII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:00 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385. The fax phone numbers of the examiner is 571- 273-1332. Since there is a newly electronic filing procedure for all initial communicating papers and all responses to an Office action, the examiner fax phone number is not for use to receive any fax in response to an Office action. Applicant is requested and required

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to send all initial communicating papers and all response to Office action to a central paper or fax receiving center for an electronic scanning procedure.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

(2) mail with a central mail receiving address:

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Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
27 February 2004

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le